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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,821	01/28/1999	JOSEPH PHILLIP BIGUS	R0998-238	5818
7590 STEVEN W ROTH IBM CORPORATION DEPARTMENT 917 3605 HIGHWAY 52 NORTH ROCHESTER, MN 559017829				
12/13/2010				
EXAMINER AKINTOLA, OLABODE				
ART UNIT 3691		PAPER NUMBER		
MAIL DATE 12/13/2010		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/238,821

**Applicant(s)**

BIGUS, JOSEPH PHILLIP

**Examiner**

OLABODE AKINTOLA

**Art Unit**

3691

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17-19, 24-26, 28-38, 40-42 and 46-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-19, 24-26, 28-38, 40-42 and 46-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said information" in line 14. It is not clear what this information refers to. Is it item information or order information? Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 9, 11-13, 18, 24-26, 32, 34-36, 41, 46, 48-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Dowling et al (USPN 6522875).

Re claims 1, 11-13, 24, 34-35, 46, 49, 50-53: Dowling teaches a method for servicing a customer, said method being carried out by a first computer system and comprising the steps of: transmitting, from said first computer system, item information (*via broadcast within a range*), said item information comprising information about available items (*for example available local restaurants*), said item information being transmitted as a first wireless transmission (abstract, col. 4, lines 9-30, col. 3, lines 20-42, col. 2, lines 13-19, 40-50); retransmitting, from said first computer system, said item information, said item information being retransmitted as a second wireless transmission (abstract, col. 4, lines 9-30, col. 3, lines 20-42, col. 2, lines 13-19, 40-50); and receiving at said first computer system order information from at least a second computer system, said order information comprising at least one user-selected item from said item information, said second computer system being moved by a customer from a first position to a second position, wherein said first position is not within range of said first wireless transmission and wherein said second position is within range of said second wireless transmission, said information being received after said customer device is moved to said second position, said information not being received as a result of a request from said second computer system (col. 10, lines 59-61, col. 4, lines 9-30, col. 3, lines 20-42, col. 2, lines 13-19, 40-50).

Re claims 2, 25, 36 and 48: Dowling teaches wherein said item information is embodied as a menu (*pick-list menu*) (col. 10, line 60).

Re claims 3 and 26: Dowling teaches displaying said item information (col. 10, line 60).

Re claim 4: Dowling teaches wherein the first computer system is embodied as a server system and wherein the second computer system is embodied as a customer device (col. 10, lines 59-61, col. 4, lines 9-30, col. 3, lines 20-42, col. 2, lines 13-19, 40-50).

Re claims 9, 18, 32 and 41: Dowling teaches displaying said order information (col. 10, lines 59-61, col. 4, lines 9-30, col. 3, lines 20-42, col. 2, lines 13-19, 40-50).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5, 6-8, 10, 14, 15, 17, 19, 28-31, 33, 37, 38, 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowling.

Re claims 5, 6, 10, 14, 15, 19, 28, 29, 33, 37, 38 and 42: Dowling does not explicitly teach that the order information includes payment information and vehicle identification information; displaying said vehicle identification information. However, the differences between the prior art and the claimed limitation are only rooted in content. And content is nonfunctional descriptive material. Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate, of which there is no evidence in the record. See *In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). See also *Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1103; 191 Fed. Appx. 959 (Fed. Circ. 2006) affirmed without written opinion Aug. 17, 2006). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Dowling to include any type of order information in order to enhance the flexibility of the system/process.

Re claims 7, 8, 17, 30, 31 and 40: Dowling does not explicitly teach validating said order information; accepting said order information when said order information is valid; and rejecting said order information when said order information is not valid; transmitting acceptance

information to said client device when said order is valid; and transmitting error information to said client device when the order is not valid.

Official notice is hereby taken that these concepts are old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Dowling to include these steps for the obvious reason of alerting the user about the validity of his input.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/238,821  
Art Unit: 3691

Page 7

/Olabode Akintola/  
Primary Examiner, Art Unit 3691